



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Alicia M. Commissioner of Patents and Trademarks
Washington, DC 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAME INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,519	07/13/2007	Satoshi Nakano	KON-1666	3475

20311 7500 02/06/2003

MUSERLIAN AND LUCAS AND MERCANTI, LLP
600 THIRD AVENUE
NEW YORK, NY 10016

EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT PAPER NUMBER

2873

DATE MAILED: 02/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/905,519

Applicant(s)

NAKANO, SATOSHI

Examiner

Jordan M. Schwartz

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15, 16 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 14 and 17 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

Attachments

- 1) ☒ Notice of References Cited (PTO-8942)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____

- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

Claims 12 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In reference to claim 12, that part of the claim stating "wherein the transparent conductive layer" lacks an antecedent basis since claim 1 is not claiming the layer as conductive. Therefore the intended dependency of the claim is not clear rendering the claim vague and indefinite. For purposes of examination it is assumed that claim 12 depends from claim 11 (not claim 1).

In reference to claim 16, that part of the claim stating "between a luminous reflectance one surface and a luminous reflectance on the other one surface" renders the surface with the anti-reflectance properties and therefore it is not clear what is

meant by "the other one surface". Furthermore, it is not clear which of the two "one surfaces" referred to in claim 16 is the same "one surface" (with the anti-reflectance properties) of claim 1. For purposes of examination the assumed meaning is "wherein a difference between a luminous reflectance of the one surface and a luminous reflectance of the other optical surface of the optical element is 1% or less".

Claim Objections

Claims 1 and 19 are objected to because of the following informalities: in line 3 of claim 1 and line 4 of claim 19, "one of surface" should be corrected to "one of the surfaces" for grammatical reasons. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11, 13, 15 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Tucker.

Tucker reads on these claims by disclosing the limitations therein including the following: an optical element (abstract) comprising a base material (column 2, lines 44 re either of "the lenses"); a layer formed on at least one of the surfaces (column 2, line 44 re "the adhesive"). Tucker further discloses that the adhesive layer includes a UV

the adhesive layer including a dye to provide selected transmission characteristics to

Art Unit: 2873

reduce the transmission of light including the 420-680 nm range (column 3, line 14 and Figures 1-2). Since the base material (the lenses) are not disclosed as absorbing radiation then the reflectance of the layer will inherently be less than the reflectance of the base material surface, this being based upon it being disclosed that the layer absorbs and reduces light transmission in light ranges that include 280-315 (i.e. "substantially all radiation up to 400nm") and 420-680 nm. Since the layer is an adhesive between two lenses (abstract) then in reference to one of the lens surfaces the adhesive layer is on the image side or eye side surface. Tucker further discloses the layering can have plural layers (column 2, lines 55-67); that the layer can comprise a conductive or metallic layer (column 5, line 20); the lens in an eyeglass (abstract). Since the layer is in the form of an adhesive, it will inherently be formed on an entire side of the base material. The layered adhesive of Tucker would inherently include a substantially inorganic material, this being reasonably based upon Tucker disclosing that the layering can include a dye to impart the transmission characteristics (column 5, lines 11-37) and it is well known in the art of lenses that dyed lenses include the use of inorganic substances. It is believed that the adhesive of Tucker would inherently have the surface resistance as claimed, this being reasonably based upon the materials and method of forming the adhesive as set forth in Tucker. Tucker further discloses the lens including a polarizing film (column 5, lines 38-45). Therefore, the polarizing film can be considered the "base material" and it would be inherently providing the selective

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tucker.

Tucker discloses as is set forth above but discloses the adhesive on just one of the surfaces of the lens. However, it is well known in the art of polarizing lenses that such lenses can be formed by stacks of polarizing sheets on both surfaces of the substrate being attached by an adhesive. Having the adhesive on both surfaces would inherently impart the same reflectance properties to both surfaces and would therefore inherently satisfy the limitations of claims 16 and 18. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the luminous properties and differences in wavelengths between the two surfaces as set forth in claims 16 and 18 since it is well known in the art of polarizing lenses that such lenses can be formed by stacks of polarizing sheets on both surfaces of the substrate being attached by an adhesive and having the adhesive on both surfaces would inherently impart the same reflectance properties to both surfaces and would therefore inherently satisfy the limitations of claims 16 and 18.

Prior Art Citations

number of the above rejected claims, however, such rejections would have been

repetitive. Belmaris et al and Austin would read on at least claim 19, however, such rejections would have been repetitive.

For applicant's information, due to the broadness of the independent claims, numerous references could have been used to reject at least the independent claims. As to claim 1, any optical element (lens, mirror, filter etc) that has a layer that absorbs both across the visible region as well as in the UV-B region would read on claim 1 since by absorbing in these regions the layer would inherently have a reflectance in these regions lower than the base material. Furthermore, as to claim 19, since applicant is claiming "in at least one of" a wavelength region..." then most sunglass lenses would read on claim 19 since most sunglasses have a layer to block across at least the visible region.

Allowable Subject Matter

Claim 12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 14 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: none of the prior art either alone or in combination disclose or teach of the

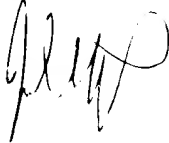
combination disclose or teach of the claimed optical element having a layer formed on at least one surface of a base material with the layer having the reflectance as set forth in claim 1, the layer comprising a transparent conductive layer, and specifically further wherein the transparent conductive layer contains indium oxide. Specifically, with reference to claim 14, none of the prior art either alone or in combination disclose or teach of the claimed optical element having a layer formed on at least one surface of a base material with the layer having the reflectance as set forth in claim 1, and specifically further wherein a luminous transmission of the layer is 90% or more. Specifically, with reference to claim 17, none of the prior art either alone or in combination disclose or teach of the claimed optical element having a layer formed on at least one surface of a base material with the layer having the reflectance as set forth in claim 1, and specifically further wherein a spectral transmission for all light rays in a wavelength region of 400 to 700 nm is 98% or more.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (703) 308-1286. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

Art Unit: 2873

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

A handwritten signature in black ink, appearing to read "J. Schwartz", written in a cursive style.

Jordan m. Schwartz
Primary Examiner
Art Unit 2873
February 4, 2003